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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,894	12/27/2001	Timothy J. Lalley	100110012-1	1270

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EXAMINER	
BROCKETTI, JULIE K	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,894	LALLEY ET AL.	
	Examiner	Art Unit	
	Julie K. Brocketti	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 6-24-05.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6,8-15 and 22-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-6,8-15 and 22-25 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 24, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 states "...the display strip comprises a plurality of display strips and the at least one player comprises a plurality of players..." It is unclear how "at least one player" can comprise a plurality of players. If there is only one player, there will not be a plurality of players and if there are a plurality of players there cannot be just one player. It appears as though this part of the claim is contradictory. Similarly, it is unclear how at least one display strip

(from claim 1) can comprise a plurality of display strips. For example, if there are a plurality of display strips there is not just one display strip.

Claim 10 states "A game, comprising: a hand-held microprocessor configured to store and execute games..." It is unclear how a single "game" as in the preamble can execute multiple "games" as in the first line of the claim, consequently, the claim is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-15 and 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. All of the claims recite "A game" in the preamble, which defines the statutory subject matter. "A game" by itself is not statutory since it is not clear as to whether it is actually a gaming machine/apparatus, a gaming method, etc. "A game" by itself does not clearly fall into one of the statutory classes as required by 35 USC 101. Consequently, the Applicant is advised to clarify directly in the claim language what statutory class "a game" refers to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Carter, III et al., U.S. Patent No. 4,695,058. Carter discloses a game and method for playing the game. At least one display strip is applied to a player. The display strip comprises a plurality of lights that are capable of displaying images. The display strip is coupled to a hand-held processor, which stores and executes game instructions for the game (See Carter col. 2 lines 47-58; col. 4 lines 58-64; col. 8 lines 66-67; col. 9 lines 1-67). For example, there is a microprocessor in the vest and one can clearly hold the vest, thereby making the microprocessor "hand-held" and the microprocessor includes memory containing instructions on how to illuminate the display strips based on signals generated throughout the game. Input is received from at least one player. Output signals are provided to the display strip from the hand-held microprocessor. Images are displayed on the display strip (See Carter Fig. 1; col. 4 lines 41-57; col. 8 lines 29-65; col. 14 lines 10-19) [claim 1]. The output signals are indicative of the player's status in the game (See Carter col. 4 lines 41-57) [claim 2]. Each player's status in the game is displayed on the display strip (See Carter col. 4 lines 41-57) [claims 3, 5, 15].

The display strip comprises a plurality of display strips and the at least one player comprises a plurality of players. The step of applying at least one display strip to at least one player comprises applying at least one display strip to each player (See Carter Fig. 1; col. 4 lines 41-57) [claims 4, 15]. Input is received from a game input device operated by the player (See Carter col. 4 lines 12-32) [claim 6]. Input is received by a simulated weapon shot (See Carter col. 14 lines 1-19) [claim 8]. An audible sound is emitted from the display strip (See Carter col. 7 lines 24-25; col. 8 lines 29-34) [claim 9]. The game comprises a hand-held microprocessor configured to store and execute games and at least one display strip in communication with the hand-held microprocessor processor. The display strip includes a plurality of lights wherein the lights are capable of displaying images received from the hand-held microprocessor. For example, the images could be merely a signal of whether an LED should be turned "on" or "off". A mounting structure is capable of mounting the display strip on the player and the display is in communication with the hand-held micro-processor (See Carter col. 2 lines 50-59; col. 4 lines 41-57; col. 8 lines 29-65; col. 9 lines 1-67; col. 14 lines 10-19) [claim 10]. The display strip comprises a plurality of displays trips and a plurality of game input devices are in communication with the hand-held microprocessor. The game input devices receive input from the players (See Carter Fig. 1; col. 2 lines 50-59; col. 4 lines 41-57) [claim 11]. Each game input device is associated with a display strip. Each game input device is arranged to receive input from

a specified player and the display strip associated with the game input device is arranged to display status information fro the specified player (See Carter col. 2 lines 24-58; col. 4 lines 40-64) [claim 12]. The display strips are in communication with the hand-held microprocessor through the game input devices (See Carter col. 2 lines 24-58) [claim 13]. At least one sensor is provided wherein the sensor is capable of sensing radiation from a simulated weapon firing and providing output to the hand-held micro-processor in response to the simulated weapon firing (See Carter col. 58-67; col. 5 lines 27)[claim 14].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter in view of Davila, U.S. Patent No. 4,602,191. Carter lacks in disclosing that the display strip is flexible and that the images comprise alphanumeric characters. Davila teaches of clothing that has a flexible LED display [claim 22]. The images displayed by the display strips comprise alphanumeric characters (See Davila Figs. 1 & 3; col. 1 lines 24-29;

col. 2 lines 1-36)[claim 23]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a flexible display strip where the images are alphanumeric characters. By using a flexible display strip, the display strips may be able to be attached to a variety of wearable items including clothing, thereby allowing more options in how a player may wear the strip. Furthermore, by displaying alphanumeric characters "X"s or the team name may be displayed rather than just a line of LEDs thereby allowing more information to be displayed to the other players.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter in view of Coffman, U.S. Patent Application Publication No. 2004/0215467 A1. Carter does not disclose that the hand-held microprocessor is a personal digital assistant (PDA). Coffman teaches that a computer can refer to any data processing device including portable computers, palm-top computers, personal digital assistants (PDA), Internet appliances, cellular or mobile telephones, set-top boxes, etc. (See Coffman ¶0125) [claims 24, 25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the processor in Carter be a personal digital assistant (PDA). As seen from Coffman, any type of data processing device can be used to process data and it is up to the inventor's discretion which type of data processing device to use. Therefore at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a personal digital assistant as the

processing device in Carter because Applicant has not disclosed that the PDA provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Carter's and Applicant's invention, to perform equally well with any type of processor since the processor perform the same function of executing the game. Therefore, it would have been prima facie obvious to modify Carter to obtain the invention as specified in claims 24 and 25 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Carter.

Response to Amendment

Claims 1, 10, 11, 13 and 14 have been amended. Claims 7 and 16 have been cancelled. It has been noted that claims 24 and 25 have been added.

Response to Arguments

Applicant's arguments filed June 24, 2005 have been fully considered but they are not persuasive.

Applicant argues that Carter does not disclose the concept of using a hand-held microprocessor such as a personal digital assistant. The Examiner agrees that Carter does not discloses a PDA; therefore, the Examiner has supplied the reference Coffman to teach that it is well known and obvious to use a PDA to substitute for other processors. The Examiner disagrees with the

statement that Carter does not disclose using a hand-held microprocessor. The Examiner notes that Carter clearly discloses throughout column 9 that the vest has a microprocessor within it. This vest can be "hand-held" thereby making the microprocessor "hand-held". The microprocessor circuitry in the vest also includes memory and instructions for executing the game. For example, the instructions allow the processor to know when to light up or extinguish the LEDs on the display strips.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would be motivated to combine the displays of Davila and the amusement shooting game of Carter so that the player could wear more flexible display strips on softer clothing rather than having to wear a bulky helmet. The fact that Davila makes no mention of using the strips for a gamin purposes does not render the combination unobvious. One of ordinary skill in the art would clearly look at Davila if they were trying to make the helmet display of Carter softer, flexible and more comfortable to wear. Furthermore, the fact that Davila and Carter were filed over 19 years ago and

nobody thought to combine the two disclosures does not mean that it would not be obvious to one of ordinary skill in the art to now combine the disclosures.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Applicant's invention uses a generic hand-held computing device that allows a variety of different types of games to be played) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner appreciates the differences between Applicant's invention and Carter; however, Applicant is still broadly claiming his invention, which allows Carter to read on the claims. The Examiner further notes that something as simple as an electronic watch with a game on it would also read on Applicant's claims, please see Smith, U.S. Patent No. 4,504,062.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brocketti whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Julie Brocketti

Julie K Brocketti
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Art Unit 3713